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09/632,208	08/03/2000	Helmut Mangold	PM271764	1169

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EXAMINER

GROUP, KARL E

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/632,208

Filing Date: August 03, 2000

Appellant(s): MANGOLD ET AL.

Thomas A. Cawley and Gautam Prakash
For Appellant

EXAMINER'S ANSWER

MAILED

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GROUP 1700

This is in response to the appeal brief filed May 19, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-8,23 and 24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,979,186	KOPPLER et al	11-1999
5,985,779	SAYCE et al	11-1999
6,012,304	LOXLEY et al	1-2000
6,209,357	BHANDARKAR et al	4-2001
6,355,587	LOXLEY et al	3-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The rejection of claim 8 under 35 U.S.C. 112, second paragraph is withdrawn.

Claims 1-8,23 and 24 stand rejected under 35 U.S.C. 102 (a, b or e) as

anticipated by or, in the alternative, under 35 U.S.C. 103 (a) as obvious over Kamo et al

(5,585,173), Koppler et al (5,979,186), Sayce et al (5,985,779), Loxely et al (6,012,304 and 6,355,587) and Bhandarkar et al (6,209,357), each reference taken alone.

Appellants are claiming a sintered material produced from silicon dioxide granulates which may be fully dense or porous.

Kamo et al '173 teach a high purity silicon dioxide sintered body produced from amorphous silica powder (see column 3, lines 5-18).

Koppler et al '186 teach the production of a sintered quartz body from a silicon dioxide granular material (see column 2, lines 3-12).

Sayce et al '779 teach a quartz glass article (see examples 1-3).

Loxley et al '587 and '304 teach the manufacture of silica and quartz glass articles (see '587, column 10, lines 57-64; and '304, column 12, lines 3-15).

Bhandarkar et al '357 teach sintered silicon dioxide bodies (see examples).

The sintered material of the instant claims is not patentably distinguishable from the sintered silica bodies taught by the prior art and the claims lack any limitations that further distinguish the claimed sintered material. The limitations set forth in the instant claims are directed to the starting materials and the process of manufacture. Appellants have not shown by way of tangible evidence how the starting materials and process of manufacture distinguishes the claimed sintered material and the claims reflect such differences.

"The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

(11) Response to Argument

Appellants argue Kamo et al fail to teach a granulate having the specific particle size set forth in the claims. This is not persuasive in overcoming the rejection because the claims are drawn to a sintered material made from the silicon dioxide granulates and therefor would no longer possess the granulate particle size, surface area and tamped density attributed to the granulates. Appellants have not clearly shown by way of tangible evidence how the claimed sintered material distinguishes from the sintered

materials of the prior art and that the claims reflect such differences. Appellants also have not set forth any arguments as to how the claimed sintered material is different from the sintered material of the prior art.

Appellants argue the tamped density taught by Koppler et al of 1000g/l is outside the ranges set forth in the claims. This is not persuasive because the tamped density is a property of the granular starting material and not that of the claimed sintered material. The claimed sintered material would not possess a tamped density. Again appellants have not shown by way of tangible evidence or argued how the claimed sintered material distinguishes from the sintered materials of the prior art.

Appellants argue Sayce et al is directed to an opaque quartz glass while the instant invention is directed to a material for the production of transparent glass. Firstly, the instant claims are not directed to a material for the production of transparent glass but are directed to a sintered material. Secondly, the claims are silent as to the sintered material being transparent. It is also agreed that Sayce et al teach a sintered material having closed pores or bubbles however the instant claims allow for porosity, see instant claim 2, last line.

Appellants argue Loxley et al '304 and '587 disclose a silica particle size of 2 to 10 microns which is outside the granulate particle size set forth in the claims. This is not persuasive because the instant claims are directed to a sintered material not a silica granulate. The sintered material would no longer possess the particle size of the silica granulate used to manufacture the sintered material. Appellants have not argued nor

submitted tangible evidence as to how the sintered material distinguishes from the sintered materials of the prior art.

Appellants argue the starting materials taught by Bhandarkar et al are different than the starting granulates of the instant invention. Again it is emphasized that the starting materials (granulates) do not patentably distinguish the claimed sintered material, which would no longer possess the properties of the starting materials. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Karl E Group

Primary Examiner

Art Unit 1755

keg
October 15, 2003

Conferees

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